

REMARKS

The Official Action mailed June 17, 2005, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to October 17, 2005.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on January 2, 2004, July 28, 2004, and March 17, 2005. A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 17-24 were pending in the present application prior to the above amendment. Independent claims 17-20 have been amended to better recite the features of the present invention, and new claims 25-30 have been added to recite additional protection to which the Applicants are entitled. Accordingly, claims 17-30 are now pending in the present application, of which claims 17-20 and 25 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Applicants specifically direct the Examiner's attention to Figure 1E of U.S. Patent No. 5,501,989 to Takayama et al., which was submitted in the Information Disclosure Statement filed January 2, 2004, and considered by the Examiner on May 31, 2005.

The Official Action rejects claims 17-23 as obvious based on the combination of U.S. Patent Application Publication No. 2003/0166336 to Kato et al. and U.S. Patent No. 5,834,327 to Yamazaki et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

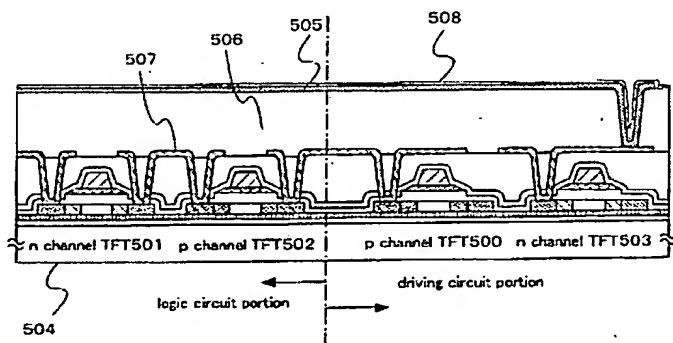
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 17-20 have been amended to recite a positional relationship between crystalline and amorphous semiconductor films. Specifically, claims 17-20 recite that an amorphous semiconductor film is located above a crystalline semiconductor film.

The Official Action relies on Kato to teach "a first semiconductor element (TFT 501) using a crystalline semiconductor film" and "a second semiconductor element (TFT 500) using an amorphous semiconductor film" (page 2, Paper No. 20050531). However, as shown in Figure 5 of Kato (reproduced herein), the semiconductor films 500, 501 of Kato are located on the same surface.

Fig. 5



Yamazaki does not cure the deficiencies in Kato. The Official Action relies on Yamazaki to teach "TFT's having active regions of crystalline silicon or amorphous silicon formed over an adhesive layer (76) and non glass substrate (75)" (page 3, Id.; referring to Figure 5C, reproduced herein). However, Kato and Yamazaki, either alone or in combination, do not teach or suggest that an amorphous semiconductor film is located above a crystalline semiconductor film.

Since Kato and Yamazaki do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Official Action asserts that dependent claim 21 is "a 'product by process' claim limitation" (page 3, Id.). The Applicants respectfully disagree and traverse the above-referenced assertion in the Official Action. Claim 21 recites a "semiconductor device ... wherein the adhesive is provided with exfoliate paper." As such, in dependent claim 21, exfoliate paper is a part of the semiconductor device. Reconsideration is requested.


The Official Action rejects dependent claim 24 as obvious based on the combination of Kato, Yamazaki and U.S. Patent Application Publication No. 2003/0134048 to Shiotsuka et al. Please incorporate the arguments above with respect to the deficiencies in Kato and Yamazaki. Shiotsuka does not cure the deficiencies in Kato and Yamazaki. The Official Action relies on Shiotsuka to allegedly teach "that a device employing a plastic substrate and amorphous silicon active layer material can be used in a photoelectric conversion element" (page 4, Id.). However, Kato and Yamazaki and Shiotsuka, either alone or in combination, do not teach or suggest that an amorphous semiconductor film is located above a crystalline semiconductor film. Since Kato and Yamazaki and Shiotsuka do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration

and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 25-30 have been added to recite additional protection to which the Applicants are entitled. The features of claims 25-30 are supported in the specification, for example, by Figure 8A and page 29, lines 8-31. For the reasons stated above, the Applicants respectfully submit that new claims 25-30 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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